

REMARKS

The Office Action mailed on March 31, 2005 has been carefully reviewed and considered. Claims 12, 13, 16-31 are currently pending and Claims 12, 13, 16 and 18-20 stand rejected. To expedite the allowance of the rejected claims, Claim 12 has been amended to more specifically claim the present invention. No new matter has been added. Reconsideration in view of the amendment above and the remarks below is respectfully requested.

Applicants thank the Examiner for considering the amendments and remarks in Applicants' response mailed on September 2, 2005. Applicants further thank the Examiner for allowing Claims 17 and 21-31.

The 35 U.S.C. § 103 Rejection

The Office Action has rejected Claims 12, 13, 16 and 18-20 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Crabtree¹ in view of Younker,² and Bailey³ among which Claim 12 is the independent claim. Without admitting that Crabtree, Younker and Bailey are prior art and reserving the right to establish that they are not prior art, Applicants respectfully traverse this rejection.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.⁴

¹ U.S. Patent No. 3,520,060.

² U.S. Patent No. 5,951,301.

³ U.S. Patent No. 5,800,179.

⁴ M.P.E.P. § 2143.

Amended Claim 12 of the present invention recites in part:

a mock anatomical site having an orifice, the orifice being configured to receive a peripheral device, wherein the mock anatomical site is pivotable, the pivotable mock anatomical site further including a retainer, a first ring disposed proximate to the orifice, the ring being configured to rotate about the retainer

a hollow member extending through the resiliency-providing material and between the orifice and the sensing assembly through the retainer and the first ring, the hollow member being configured to guide the peripheral device from the orifice to the sensing assembly. (Emphasis added)

In other words, Claim 12 claims an apparatus having a hollow member, which extends between the orifice and the sensing assembly through the retainer and the first ring and the hollow member is used to guide the peripheral device from the orifice to the sensing assembly.

The Office Action, however, rejects Claim 12 and asserts that “[r]egarding claim 12, Crabtree et al discloses a mock anatomical apparatus ... containing a retainer and a first ring disposed proximate to the orifice, the ring configured to rotate about the retainer (Col 3, lines 65-70).” See page 3 of the Office Action. Furthermore, the Office Action asserts that “Crabtree discloses a retainer (Figure 1, item 60) and a first ring configured to rotate about the retainer (Figure 1, item 58).” See page 6 of the Office Action. Applicants respectively disagree with these assertions.

Applicants submit that Crabtree does not disclose all of the limitations of Claim 12. Crabtree fails to disclose a hollow member that extends between the orifice and the sensing assembly through the retainer and the first ring and the hollow member used to guide the peripheral device from the orifice to the sensing assembly. As such, Crabtree can not render amended Claim 12 obvious under §103, because Crabtree does not disclose the claimed hollow member.

The Office Action further asserts that it would be obvious to one having ordinary skill in the art at the time of the invention to combine Crabtree, Younker, and Bailey to practice the presently claimed invention. The Applicants respectfully disagree with this assertion.

Applicants respectfully submit that a desired outcome that the invention provides cannot be used as the motivation to combine the references if there is no such teaching or suggestion in the references. Since neither Crabtree nor Younker and Bailey teach or suggest a combination between Crabtree, Younker and Bailey, Applicants contend that there is no teaching to combine.

Even assuming for the sake of argument that Crabtree and Younker and Bailey were combined, the combination would still fail to render the present invention obvious, because neither Crabtree nor Younker nor Bailey nor a combination of the three discloses or suggests a hollow member that extends between the orifice and the sensing assembly through the retainer and the first ring where the hollow member is used to guide the peripheral device from the orifice to the sensing assembly. Accordingly, one of ordinary skill in the art would not combine Crabtree and Younker and Bailey to yield subject matter of Claim 12, because even if these references were combined, the combination would still fail to disclose or suggest each and every element disclosed in Claim 12. At least for these reasons stated above, Claim 12 is patentable over Crabtree in view of Younker and Bailey under §103.

If the independent claims are valid, the claims that depend from the independent claims should also be valid as matter of law. See Jenric/Pentron, Inc. v. Dillon Co., 205 F. 3d 1377, 1382 (Fed. Cir. 2000). Since Claims 13, 16 and 18-20 depend from allowable independent Claim 12, Claims 13, 16 and 18-10 should also be patentable as matter of law.

Conclusion

Based on all of the above, Applicants believe all claims now pending in the present application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

No additional fees are believed to be due at this time. However, please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Applicants thank the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Jim Wu at (408)282-1885.

Respectfully submitted,

THELEN REID & PRIEST, LLP



Suvashis Bhattacharya
Reg. No. 46,554

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Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040